

Serial No. 10/588,388
60469-106 PUS1; 5254-US

2. Rejection of Claims 22, 27-31, 33, 35, 36, and 45 under 35 U.S.C. § 102(b)

Claim 22 requires a fastening member received at least partially into openings to secure the first segments to each other and to place the first and second clips in a fixed position relative to each other.

U.S. Patent 4,577,729 ("*Karol*") does not disclose this feature. The Examiner argues that clips 40, 42 are secured to each other through bracket 140, and projections 162, 168. It is understood that the Examiner is permitted to broadly read claim terms, however, any such reading is limited to an interpretation that would be reasonable. In this instance, claim 22 requires "first and second clips securable to each other." Further, claim 22 requires a fastening member received within openings of the first segments to secure the first segments of the clips "to each other." It is clear from the claim terms that the claimed clips are secured to each other, not to a common intermediate part. *Karol's* clips 40, 42 are not secured to each other.

Additionally, *Karol* does not have a single fastener received through multiple clip openings. Each of the clips 40, 42 in the reference has its own fastener so that there is one fastener for each opening. Claim 22, on the other hand, recites *a fastening member* at least partially received into *openings* to secure the first segments to each other.

Claim 22 also requires that the clips are securable for "establishing a selectively adjustable clamp dimension." Although the clips 40, 42 in *Karol* include an elongated slot 202, they are not adjustable. Instead, the clips 40, 42 include a slot that receives projections 162, 168 of the steel plate 140 such that no adjustment can be made of a clamping dimension. The slots 202 are provided to allow the rail to be received between the clips 40, 42 during installation (*Karol*, Column 4, line 58 to Column 5, line 14). Once the rail is in place, the clips 40, 42 are set in the secured place. No adjustment of a clamping dimension is possible. Accordingly, claim 22 recites features not disclosed by *Karol*. Applicant requests reconsideration and withdrawal of this rejection.

Claim 31 requires first and second overlapping clips adjustably secured to each other and to a mount. The clips 40, 42 are not overlapping each other. Therefore, there is no anticipation.

Further, as discussed above, *Karol* does not disclose "establishing a selectively adjustable clamping dimension." Instead, the *Karol* clips 40, 42 provide only a fixed clamping dimension. Claim 31 is not anticipated by *Karol*.

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None of the claims depending from claims 22 and 31 are anticipated, either. The rejection should be withdrawn.

3. Rejection of Claims 24, 25, 37-39, 41-44 and 46 under 35 U.S.C. § 103(a)

A. Rejection of Claims 24 and 25

Claims 24 and 25, which were rejected under 35 U.S.C. § 103(a) as allegedly being obvious when considering *Karol* in view of U.S. Patent No. 5,316,108 ("*Pearson*"), depend from claim 22. As previously discussed, *Karol* fails to teach or suggest each of the limitations of claim 22. *Pearson* fails to cure the deficiencies of *Karol* with respect to claim 22.

Accordingly, the combination of *Karol* and *Pearson* cannot be used to establish a *prima facie* case of obviousness. Therefore, a withdrawal of the 35 U.S.C. § 103(a) rejection of claims 24 and 25 based on *Karol* and *Pearson* is earnestly solicited.

B. Rejection of Claims 37-39, 41-44 and 46

Claims 37-39, 41-44 and 46 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious when considering *Karol* in view of U.S. Patent No. 995,075 ("*McDermott*").

Claim 37 requires the step of positioning a first clip 20A and a second clip 20B about a guide rail 12 by securing the first clip 20A to the second clip 20B, with at least part of the first and second clips overlapping each other. The Examiner proposes that somehow *Karol* discloses the step of securing one clip to another clip. However, this feature is simply not disclosed for the reasons discussed above. As is clear from claim 37, one clip is secured to the other, not to some common intermediate part as is disclosed in *Karol*.

Additionally, the Examiner argues that *McDermott* members 4, 3 disclose the overlapping feature missing from *Karol*. *McDermott* discloses member 4 that fits within a member 3, but that is not secured to each other. Instead, the member 4 is secured to a railroad tie 1, and traps the member 3 against the rail and cotter pin 9. The member 3 is not secured to the member 4. Accordingly, even with the addition of *McDermott*, the proposed combination does not disclose all the claimed overlapping. Additionally, the clips 40, 42 of *Karol* cannot possibly overlap each other unless they were completely redesigned using improper hindsight.

Accordingly, claim 37 cannot be obvious over *Karol* and *McDermott* as not all the features are disclosed nor does the structure provide any reason to suggest such features.

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Applicant, requests reconsideration and withdrawal of the rejection of claims 37-39, 41-44, and 46.

CONCLUSION

The claims are believed in condition for allowance. No additional fees are required. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.



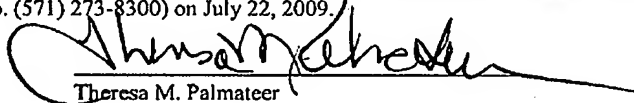
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CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 10/588,388, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on July 22, 2009.


Theresa M. Palmateer